

### IN THE CLAIMS

1. (Original) A corrosion inhibiting coating composition comprising:  
a rare earth compound; and  
a binder.
2. (Original) The composition of claim 1 wherein the rare earth compound is selected from the group consisting of rare earth oxides, mixed oxides, solid solution oxides, hydroxides, hydrated oxides, salts, triflates, complexes and combinations thereof.
3. (Original) The composition of claim 2 wherein the rare earth compound is anhydrous or hydrated.
4. (Original) The composition of claim 1 wherein the rare earth compound comprises one or more metal cations selected from the group consisting of praseodymium, terbium, cerium, samarium, ytterbium, yttrium, neodymium and combinations thereof.
5. (Currently Amended) The ~~coating~~ composition of claim 1 wherein the rare earth compound is selected from the group consisting of cerium oxide, cerium hydroxide, cerium solid solution mixed oxide, cerium oxide mixture, cerium salt, neodymium oxide, neodymium hydroxide, neodymium solid solution mixed oxide, neodymium oxide mixture, neodymium salt, praseodymium oxide, praseodymium hydroxide, praseodymium solid solution mixed oxide, praseodymium oxide mixture, praseodymium salt, ytterbium oxide, ytterbium hydroxide, ytterbium solid solution mixed oxide, ytterbium oxide mixture, ytterbium salt, yttrium oxide, yttrium hydroxide, yttrium solid solution mixed oxide, yttrium oxide mixture, yttrium salt, terbium oxide, terbium hydroxide, terbium solid solution mixed oxide, terbium oxide mixture, terbium salt, and combinations thereof.
6. (Original) The composition of claim 1 wherein the rare earth compound is a

praseodymium compound.

7. (Original) The composition of claim 6 wherein the praseodymium compound is selected from the group consisting of praseodymium(III), praseodymium(III/IV), praseodymium(IV) compounds and mixtures thereof.

8. (Original) The composition of claim 6 wherein the praseodymium compound is a praseodymium(III) compound.

9. (Currently Amended) The ~~coating~~ composition of claim 8 wherein the praseodymium(III) compound is a praseodymium(III) oxide..

10. (Original) The composition of claim 6 wherein the praseodymium compound is a praseodymium(III/IV) compound.

11. (Currently Amended) The ~~coating~~ composition of claim 10 wherein the praseodymium(III/IV) compound is a praseodymium(III/IV) oxide.

12. (Original) The composition of claim 6 wherein the praseodymium compound is a praseodymium(IV) compound.

13. (Original) The composition of claim 1 comprising about 0.1 to about 90 wt%  $\text{Pr}_6\text{O}_{11}$ .

14. (Original) The composition of claim 1 comprising about 0.1 to about 28 wt%  $\text{Pr}_6\text{O}_{11}$ .

15. (Currently Amended) The ~~coating~~ composition of claim 1 further comprising one or more neutral to slightly acidic generating extenders or one or more acidic generating extenders.

16. (Currently Amended) The ~~coating~~ composition of claim 15 wherein the one or more

neutral to slightly acidic generating extenders or one or more acidic generating extenders is a ~~sulfur, phosphorus or silicon~~ sulfur, phosphorus or silicon oxyanion-containing salt.

17. (Original) The composition of claim 1 wherein the composition is selected from the group consisting of aqueous, solvent-based, and powder coating compositions.
18. (Currently Amended) The composition of claim ~~[[17]]~~ 1 wherein the composition is an aqueous composition.
19. (Original) The composition of claim 2 wherein the binder is an organic polymer selected from the group consisting of epoxy, urethane, urea, acrylate, alkyd, melamine, polyester, vinyl, vinyl ester, silicone, siloxane, silicate, sulfide, sulfone, epoxy novolac, epoxy phenolic, amides, drying oils, and hydrocarbon polymers.
20. (Currently Amended) The composition of claim ~~[[19]]~~ 2 wherein the ~~organic polymer~~ binder is an epoxy polymer.
21. (Original) The composition of claim 2 in combination with a material selected from the group consisting of linear and cyclic dextrans, triflic acid, triflates, acetates, talc, kaolin, organic-based ion exchange resins, and combinations thereof.
22. (Original) The composition of claim 21 comprising about 0.03 to about 5 wt% cyclodextrin, about 0.1 to about 0.5 wt % triflic acid, or about 0.1 to about 5 wt% ionic exchange resin.
23. (Original) The composition of claim 2 further comprising a material selected from the group consisting of gelatin and gelatin derivatives.
24. (Original) The composition of claim 23 comprising about 0.03 to about 5 wt% gelatin.

25. (Currently Amended) The composition of claim 2 further comprising a material selected from the group consisting of amino acids, amino acid derivatives  $[[o]]$  and combinations thereof.
26. (Original) The composition of claim 25 wherein the amino acid is selected from the group consisting of glycine, arginine, and methionine.
27. (Original) The composition of claim 25 wherein the amino acid derivative is methionine sulfoxide or methionine methyl sulfoxide.
28. (Original) The composition of claim 22 comprising about 0.1 to about 5 wt% amino acid.
29. (Currently Amended) The composition of claim  $[[2]]$  1 wherein the rare earth compound is a rare earth carbonate or a rare earth triflate.
30. (Original) The composition of claim 2 further comprising a coloring pigment.
31. (Original) The composition of claim 30 wherein the coloring pigment is  $TiO_2$ .
32. (Original) A substrate coated with the composition of claim 1.
33. (Original) The substrate of claim 32 wherein the substrate is selected from the group consisting of aluminum, aluminum alloys, steel, galvanized steel, zinc, zinc alloys, magnesium, and magnesium alloys.
34. (Currently Amended) The substrate of claim  $[[33]]$  32 wherein the substrate is aluminum.

35. (Original) A corrosion inhibiting composition comprising:  
a rare earth compound;  
a binder; and  
a neutral to slightly acidic generating extender or an acidic generating extender.
36. (Currently Amended) The ~~coating~~ composition of claim 35 wherein the neutral to slightly acidic generating extender or the acidic generating extender is a sulfur, phosphorus or silicon oxyanion-containing salt.
37. (Original) The composition of claim 35 wherein the neutral to slightly acidic generating extender or the acidic generating extender is an anhydrous or hydrous lanthanide sulfate.
38. (Currently Amended) The composition of claim ~~[[35]]~~ 138 wherein the metal sulfate is a ~~neutral to slightly acidic generating extender or the acidic generating extender~~ is selected from the group consisting of anhydrous magnesium sulfate, hydrous magnesium sulfate, anhydrous calcium sulfate, hydrous calcium sulfate, barium sulfate, samarium sulfate, and strontium sulfate.
39. (Currently Amended) The composition of claim ~~[[38]]~~ 138 wherein the metal sulfate is hydrous calcium sulfate, anhydrous calcium sulfate or strontium sulfate.
40. (Original) The composition of claim 38 comprising about 1 to about 99 wt% metal sulfate.
41. (Original) The composition of claim 38 comprising about 45 to about 75 wt% metal sulfate.
42. (Currently Amended) The composition of claim 36 wherein the rare earth ~~compound~~ compound is selected from the group consisting of rare earth oxides, hydroxides, mixed oxides, solid solution oxides, hydrated oxides, salts, triflates, complexes, and combinations thereof.

43. (Original) The composition of claim 36 wherein the rare earth compound comprises one or more metal cations selected from the group consisting of praseodymium, terbium, cerium, samarium, ytterbium, yttrium, neodymium and combinations thereof.

44. (Original) The composition of claim 36 wherein the rare earth compound is a praseodymium compound.

45. (Original) The composition of claim 44 wherein the praseodymium compound is selected from the group consisting of praseodymium(III), praseodymium(III/IV), praseodymium(IV) compounds and combinations thereof.

46. (Original) The composition of claim 44 wherein the praseodymium compound is a praseodymium(III) compound.

47. (Original) The coating composition of claim 44 wherein the praseodymium compound is a praseodymium(III) sulfate or a praseodymium(III/IV) oxide.

48. (Original) The composition of claim 44 wherein the praseodymium compound is a praseodymium(III/IV) compound.

49. (Original) The composition of claim 44 wherein the praseodymium compound is a praseodymium(IV) compound.

50. (Original) The composition of claim 43 wherein the composition is selected from the group consisting of aqueous, solvent-based, and powder coating compositions.

51. (Original) The composition of claim 43 wherein the binder is an organic polymer selected from the group consisting of epoxy, urethane, urea, acrylate, alkyd, melamine, polyester,

vinyl, vinyl ester, silicone, siloxane, silicate, sulfide, sulfone, polysulfide, epoxy novolac, epoxy phenolic, amides, drying oils, and hydrocarbon polymers.

52. (Currently Amended) The composition of claim ~~[[51]]~~ 43 wherein the ~~organic polymer binder~~ is an epoxy polymer.

53. (Original) The composition of claim 43 wherein the binder is an inorganic polymer selected from the group consisting of silicone, siloxane and silicate polymers.

54. (Original) The composition of claim 43 further comprising a coloring pigment.

55. (Original) The composition of claim 54 wherein the coloring pigment is TiO<sub>2</sub>.

56. (Original) A corrosion inhibiting primer composition comprising:  
a praseodymium (III/IV) mixed oxide; and  
a binder.

57. (Original) The composition of claim 56 wherein the composition is selected from the group consisting of aqueous, solvent-based, and powder coating compositions.

58. (Original) The composition of claim 56 wherein the binder is an organic polymer selected from the group consisting of epoxy, urethane, urea, acrylate, alkyd, melamine, polyester, vinyl, vinyl ester, silicone, siloxane, silicate, sulfide, sulfone, polysulfide, epoxy novolac, epoxy phenolic, amides, drying oils, and hydrocarbon polymers.

59. (Currently Amended) The composition of claim ~~[[58]]~~ 56 wherein the ~~organic polymer binder~~ is an epoxy polymer.

60. (Original) The composition of claim 56 wherein the binder is an inorganic polymer selected from the group consisting of silicone, siloxane and silicate polymers.
61. (Original) The composition of claim 56 further comprising a coloring pigment.
62. (Original) The composition of claim 61 wherein the coloring pigment is  $\text{TiO}_2$
63. (Original) A corrosion inhibiting coating composition comprising:  
a binder; and  
a rare earth element mixed oxide comprising two or more rare earth element oxides selected from the group consisting of oxides, mixed oxides, solid solution oxides, hydrated oxides and hydroxides.
64. (Currently Amended) The composition of claim 63 wherein at least one of the two or more rare earth element oxides is selected from the group consisting of  $\text{Y}_2\text{O}_3$ ;  $\text{La}_2\text{O}_3$ ,  $\text{CeO}_2$ ,  $\text{Pr}(\text{OH})_3$ ,  $\text{PrO}_2$ ,  $\text{Pr}_2\text{O}_3$ ,  $\text{Pr}_6\text{O}_{11}$ ,  $\text{Nd}_2\text{O}_3$ ,  $\text{Sm}_2\text{O}_3$ ,  $\text{Tb}_4\text{O}_7$ , and  $\text{Yb}_2\text{O}_3$ .
65. (Currently Amended) The composition of claim 63 wherein at least one of the two or more rare earth element oxides is selected from the group consisting of  $\text{PrO}_2$ ,  $\text{Pr}_2\text{O}_3$ , and  $\text{Pr}_6\text{O}_{11}$ .
66. (Original) The composition of claim 63 further comprising a neutral to slightly acidic generating extender or an acidic generating extender.
67. (Currently Amended) A corrosion inhibiting coating composition comprising:  
a binder; and  
one or more rare earth ~~praseodymium or terbium~~ element oxides selected from the group consisting of oxides, mixed oxides, solid solution oxides, hydrated oxides and hydroxides.



68. (Currently Amended) The composition of claim ~~[[67]]~~ 139 wherein ~~at least one of the~~ rare earth ~~element oxides~~ praseodymium oxide is selected from the group consisting of  $\text{PrO}_2$ ,  $\text{Pr}_2\text{O}_3$ , and  $\text{Pr}_6\text{O}_{11}$ .

69. (Original) The composition of claim 67 further comprising a neutral to slightly acidic generating extender or an acidic generating extender.

70. (Currently Amended) A corrosion inhibiting coating composition having a local pH or ionic activity comprising:

a binder; ~~[[and]]~~

one or more rare earth element oxides selected from the group consisting of oxides, mixed oxides, solid solution oxides and hydroxides, wherein at least one of the one or more rare earth element oxides is an anhydrous praseodymium oxide; and

a metal sulfate.

71. (Original) A corrosion inhibiting coating composition comprising:

an effective corrosion inhibiting amount of one or more neutral to slightly acidic generating extenders or acidic generating extenders; and

a binder.

72. (Original) The composition of claim 71 wherein the binder is an organic polymer selected from the group consisting of epoxy, urethane, urea, acrylate, alkyd, melamine, polyester, vinyl, vinyl ester, silicone, siloxane, silicate, sulfide, sulfone, polysulfide, epoxy novolac, epoxy phenolic, amides, drying oils, and hydrocarbon polymers.

73. (Currently Amended) The composition of claim ~~[[72]]~~ 71 wherein the ~~organic polymer~~ binder is an epoxy polymer.

74. (Original) The composition of claim 71 wherein the binder is an inorganic polymer

selected from the group consisting of silicone, siloxane and silicate polymers.

75. (Canceled)

76. (Currently Amended) The composition of claim 71 ~~wherein the binder is a composite~~  
further comprising one or more color pigments.

77. (Currently Amended) The composition of claim 76 wherein one of the composite is a  
~~carbon fiber composite~~ one or more color pigments is TiO<sub>2</sub>.

78. (Currently Amended) The composition of claim 71 wherein at least one of the one or  
more neutral to slightly acidic generating extenders or acidic generating ~~extender~~ extenders is a  
sulfur, phosphorus or silicon oxyanion-containing salt.

79. (Currently Amended) The composition of claim 78 wherein the ~~sulfur, phosphorus or~~  
~~silicon~~ sulfur, phosphorus or silicon oxyanion-containing salt is selected from the group  
consisting of a metal cation sulfate, a metal cation sulfite, a metal cation sulfonate, a metal cation  
protonated phosphate, a cation phosphate, a metal cation phosphonite, an oxyphosphate, a clay  
mineral kaolin and combinations thereof.

80. (Original) The composition of claim 71 wherein the one or more neutral to slightly  
acidic generating extenders or acidic generating extenders are added at a weight percent of about  
100% of total extender content.

81. (Original) The composition of claim 71 further comprising other components selected  
from the group consisting of linear and cyclic dextrans, triflic acid, triflates, acetates, talc, kaolin,  
organic-based ion exchange resins, and combinations thereof.

82. (Original) The composition of claim 71 further comprising gelatin, gelatin derivatives,

and combinations thereof.

83. (Original) The composition of claim 71 further comprising amino acids, derivatives of amino acids, and combinations thereof.

84. (Original) A substrate coated with the composition of claim 71.

85. (Original) The substrate of claim 84 wherein the substrate is selected from the group consisting of aluminum, aluminum alloys, steel, galvanized steel, zinc, zinc alloys, magnesium, magnesium alloys and composites.

86. (Currently Amended) The substrate of claim ~~[[85]]~~ 84 wherein the substrate is aluminum.

87. (Original) A corrosion inhibiting composition comprising:  
an effective corrosion-inhibiting amount of a neutral to slightly acidic generating extender  
or an acidic generating extender having a metal cation selected from the group consisting of  
calcium, strontium, and barium; and  
a binder.

88. (Original) The composition of claim 87 wherein the binder is an organic polymer.

89. (Currently Amended) The composition of claim ~~[[87]]~~ 88 wherein the organic polymer is selected from a group consisting of epoxy, urethane, urea, acrylate, alkyd, melamine, polyester, vinyl, vinyl ester, silicone, siloxane, silicate, sulfide, sulfone, epoxy novolac, epoxy phenolic, amides, drying oils, hydrocarbon polymers and combinations thereof.

90. (Original) The composition of claim 87 wherein the binder is an inorganic polymer.

91. (Original) The composition of claim 90 wherein the inorganic polymer is selected from a group consisting of silicates, silicones, silicate polymers, and combinations thereof.

92. (Currently Amended) The composition of claim 87 wherein the neutral to slightly acidic generating extender or acidic generating extender is ~~a metal cation~~ selected from the group consisting of metal cation sulfates, metal cation phosphates, metal cation silicates, and combinations thereof.

93. (Currently Amended) The composition of claim 87 ~~further comprising~~ wherein the neutral to slightly acidic generating extender or acidic generating extender comprises a metal cation ~~[[is]]~~ selected from the group consisting of yttrium, a lanthanide, and combinations thereof.

94 (Original) The composition of claim 87 wherein the neutral to slightly acidic generating extender or the acidic generating extender is a metal sulfate.

95. (Original) The composition of 87 wherein the neutral to slightly acidic generating extender or acidic generating extender is added in a weight percent of about 100% of total extender content.

96. (Original) The composition of claim 87 further comprising other components selected from the group consisting of linear and cyclic dextrans, triflic acid, triflates, acetates, talc, kaolin, organic-based ion exchange resins, and combinations thereof.

97. (Original) The composition of claim 87 further comprising gelatin, gelatin derivatives, and combinations thereof.

98. (Original) The composition of claim 87 further comprising amino acids, derivatives of amino acids and combinations thereof.

99. (Currently Amended) A coating system comprising:  
a coating containing an effective corrosion-inhibiting amount of one or more rare earth compounds, one or more neutral to slightly acidic generating extenders or one or more acidic generating extenders applied to a substrate.
100. (Original) The coating system of claim 99 further comprising one or more pretreatment coatings applied to the substrate to form a pretreated substrate and a topcoat.
101. (Original) The coating system of claim 100 wherein the topcoat is a urethane topcoat.
102. (Original) The coating system of claim 99 wherein the coating system is a resin system.
103. (Original) The coating system of claim 99 wherein the coating system is selected from the group consisting of a UV-coating system, electrolytic coating system, appliqué, powder coating system, and microwave coating system.
104. (Original) The coating system of claim 99 wherein the substrate is coated by a method selected from the group consisting of spraying, brushing, rolling and dipping.
105. (Original) The coating system of claim 99 wherein the substrate is a composite substrate.
106. (Original) The coating system of claim 99 wherein the substrate is selected from the group consisting of aluminum, aluminum alloys, steel, galvanized steel, zinc, zinc alloys, magnesium, and magnesium alloys.
107. (Original) A coating system comprising:  
one or more pretreatment coatings applied to a substrate to form a pretreated substrate;  
and  
a coating containing an effective corrosion-inhibiting amount of a corrosion-inhibiting

carbon pigment combined with a neutral to slightly acidic generating extender or an acidic generating extender, the coating applied to the pretreated substrate.

108. (Original) The coating system of claim 107 further including a urethane topcoat.

109. (Original) The coating system of claim 106 wherein the coating system is selected from the group consisting of a UV-coating system, electrolytic coating system, appliqué, powder coating system, and microwave coating system.

110. (Original) The coating system of claim 106 wherein the pretreated substrate is coated by a method selected from the group consisting of spraying, brushing, rolling and dipping.

111. (Original) A coating system comprising:

One or more pretreatment coatings applied to a substrate to form a pretreated substrate;  
and

a coating containing an effective corrosion-inhibiting amount of one or more rare earth compounds, one or more neutral to slightly acidic generating extenders or one or more acidic generating extenders; and

at least one or more other components, the coating applied to the pretreated substrate.

112. (Original) The coating system of claim 111 further including a urethane topcoat.

113. (Original) The coating system of claim 111 wherein the coating system is a resin system.

114. (Original) The coating system of claim 111 wherein the coating system is selected from the group consisting of a UV-coating system, electrolytic coating system, appliqué, powder coating system, and microwave coating system.

115. (Currently Amended) The coating system of ~~claim 111~~ claim 111 wherein the pretreated

substrate is coated by a method selected from the group consisting of spraying, brushing, rolling and dipping.

116. (Original) The coating system of claim 111 wherein the pretreated substrate is a composite substrate.

117. (Currently Amended) A method for coating a substrate with a composition comprising treating the substrate with [[a]] the composition of claim 1, and curing the applied composition.

118. (Original) A method for coating a substrate comprising treating the substrate with a conversion coating, applying the composition of claim 1, and curing the applied composition.

119. (Original) The method of claim 118 wherein the conversion coating is selected from the group consisting of cerium conversion coatings, praseodymium conversion coatings, phosphate conversion coatings, zinc-type conversion coatings, and chromium conversion coatings and anodized-type coatings.

120. (Currently Amended) The method of claim [[119]] 118 wherein the conversion coating is a chromium conversion coating.

121. (Original) A method for preparing a coating composition comprising:  
preparing a paint formulation; and  
adding an effective corrosion-inhibiting amount of a rare earth compound, a neutral to slightly acidic generating extender or an acidic generating extender to the paint formulation to produce a coating composition.

122. (Original) The method of claim 121 further comprising pre-dispersing the rare earth compound, the neutral to slightly acidic generating extender or acidic generating extender with a dispersant.

123. (Original) A method comprising:  
providing a substrate to be coated; and  
coating the substrate with a coating composition having an effective corrosion-inhibiting amount of a rare earth compound, a neutral to slightly acidic generating extender or an acidic generating extender.
124. (Original) The method of claim 123 wherein the substrate is a pretreated substrate.
125. (Original) The method of claim 124 wherein the pretreated substrate is coated by a method selected from the group consisting of spraying, brushing, rolling and dipping.
126. (Original) The method of claim 123 further comprising applying a topcoat.
127. (Currently Amended) The ~~coating~~ composition of claim ~~[[7]]~~ 15 wherein at least one of the one or more neutral to slightly acidic generating extenders or one or more acidic generating extenders is a ~~sulfur, phosphorus or silicon~~ sulfur, phosphorus or silicon oxyanion-containing salt.
128. (Currently Amended) The ~~coating~~ composition of claim ~~[[7]]~~ 15 wherein at least one of the one or more neutral to slightly acidic generating extenders or one or more acidic generating extenders is a sulfate.
129. (Currently Amended) The ~~coating~~ composition of claim ~~[[115]]~~ 128 wherein the sulfate is a metal sulfate.
130. (Currently Amended) The ~~coating~~ composition of claim ~~[[116]]~~ 129 wherein the metal sulfate is selected from the group consisting of calcium sulfate, strontium sulfate, magnesium sulfate, barium sulfate and combinations thereof.



131. (Currently Amended) The ~~coating~~ composition of claim ~~[[7]]~~ 15 wherein at least one of the one or more neutral to slightly acidic generating extenders or one or more acidic generating extenders is a phosphate.

132. (Currently Amended) The ~~coating~~ composition of claim ~~[[29]]~~ 44 wherein the ~~rare earth~~ praseodymium compound is a praseodymium(III) sulfate or a praseodymium(III/IV) oxide.

133. (Currently Amended) The ~~coating~~ composition of claim ~~[[57]]~~ 66 wherein the extender is substantially soluble.

134-135. (Canceled)

136. (Original) The coating system of claim 106 wherein the coating system is a resin system.

137. (Currently Amended) The ~~coating~~ composition of claim 128 wherein the sulfate is a praseodymium sulfate.

Please add the following new claims:

138. (New) The composition of claim 35 wherein the neutral to slightly acidic generating extender or an acidic generating extender is a metal sulfate.

139. (New) The composition of claim 63 wherein at least one of the one or more rare earth element oxides is a rare earth praseodymium oxide or a rare earth terbium oxide.

140. (New) The substrate of claim 85 wherein the composite is a carbon fiber composite

PRELIMINARY AMENDMENT  
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### CONCLUSION

Claims 5, 9, 11, 15, 16, 18, 20, 25, 29, 34, 36, 38, 39, 42, 52, 59, 64, 65, 67, 68, 70, 73, 76-79, 86, 89, 92, 93, 99, 115, 117, 120, and 127-133 have been amended; claims 75 and 134-135 have been canceled; claims 138-140 have been added. Claims 1-74, 76-133 and 136-140 are pending in the application.

No new matter has been added as a result of these amendments.

The Examiner is invited to telephone Applicant's attorney at (515) 233-3865 to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Respectfully Submitted,

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CERTIFICATE UNDER 37 CFR § 1.8: The undersigned hereby certifies that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail, in an envelop addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on this 20<sup>th</sup> day of August 2004.

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